

Attorney Docket No.: 034164.002



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Nicholas RUSSELL, et al.

Serial No.: 10/522,809

Group Art Unit: To Be Assigned

Filed: January 31, 2005

Examiner: To Be Assigned

For : ANIMATED MESSAGING

**RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)****MAIL STOP PCT**

Commissioner for Patents  
Office of PCT Legal Administration  
P.O. Box 1450  
Alexandria, VA 22313-1450

RECEIVED

November 17, 2006

24 NOV 2006

Legal Staff  
International Division

Sir:

In response to the Decision on Petition dated September 27, 2006, applicants respectfully request reconsideration and provides additional information including a further Declaration of Nicholas Russell.

The subject matter of our previous petitions is hereby incorporated by reference. Our original petition and renewed petition of July 5, 2006 included signed declarations of Nicholas Russell. Mr. Russell now provides a further declaration setting forth various facts and circumstances within his first hand knowledge and stating his current beliefs particularly related to the name issue raised in the Decision of September 27, 2006.

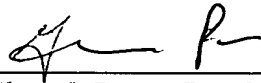
The Decision of September 27, 2006 indicated that further information should be provided addressing the different names used by one of the applicants who has gone by and used the names: "Andrew Felich" and "Anton Felich". These two names were used by the SAME PERSON. The further declaration of Nicholas Russell filed hereiwith addresses the name issue and is believed to be sufficient to overcome the last remaining issue raised with respect to inventor's signatures on this application.

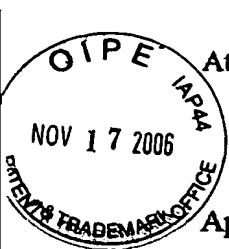
If any fees are due in connection with the filing of this Renewed petition, such as fees under 37 C.F.R. §§1.16 or 1.17, please charge the fees to Deposit Account 02-4300; Order No. 034164.002.

Respectfully submitted,  
SMITH, GAMBRELL & RUSSELL, LLP

Date: November 17, 2006

By:

  
\_\_\_\_\_  
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**DECLARATION OF NICHOLAS RUSSELL**

**MAIL STOP PETITIONS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

I, Nicholas Russell, declare as follows:

1. I have first hand knowledge of the matters set forth herein.
2. I believe that I am a co-inventor of inventions described and claimed in US Application 10/522,809. Furthermore and based on my understanding of the patent law of the United States of America, I believe that Nicholas Russell, Anton Felich and James Jenkins are co-inventors because they each contributed to at least one claim of the application as originally filed at the United States Patent and Trademark Office.
3. At the time we made the inventions described in the application, I, Nicholas Russell, and Mr Anton Felich were employed by E-Clips Intelligent Agent Technologies Pty Ltd, whose assets were subsequently purchased by InChain Pty Ltd by way of a sale agreement.
4. The present declaration concerns a decision of the US Patent Office dated 27 September 2006.

5. On the last paragraph on page 2 of the decision it is stated that "The decision mailed 05 May 2006 also indicated that item (4) had been met. However upon further review it is noted that the international application indicates the inventor as Andrew Felich while the declaration of inventors filed 10 November 2005 identifies the inventor as Anton Felich. Thus the declaration of inventors is not in compliance with 37 CFR 1.47(a)-(b). If applicant's correct name is Anton Felich, as would appear to be the case, an acceptable explanation of how applicant was named as Andrew Felich rather than Anton Felich in the Application 10/522,809 international publication is required."

6. Appendix A to this declaration is copy of a print out of the first page of International Patent Publication WO2004/012151 (Application 10/522,809 international publication referred to above). As is evident from Appendix A the International Publication of the PCT specifies the inventors as comprising Nicholas Russell, Andrew Felich and James Jenkins.

7. At the time of filing the International Application for US Application 10/522,809 I believe that Mr Anton Felich's name was correctly conveyed to Pipers Patent and Trade Mark Attorneys (Pipers), the Patent Attorneys Acting for E-Clips Intelligent Agent Technologies Pty Ltd (E-clips) at the time.

8. On 31 March 2003 Pipers submitted the PCT Application forms directly to the Australian Patent Office. When E-Clips received a copy of details of the application I observed that the name of Mr Anton Felich being had been incorrectly specified as Mr Andrew Felich. The error was noted and discussed with Pipers. Pipers subsequently advised E-Clips that the error could be corrected at a future stage in the application process.

8. I subsequently forgot to address the error which subsequently propagated into US Application 10/522,809 and into each of the national filings based on the International Application.

10. At the time of considering the error I was informed that the error was a formality and could be easily addressed. If I had been informed that the error was important I would have ensured that it was corrected.

11. I believe that the error is a clerical error and note that to my knowledge the only Felich associated with E-Clips Intelligent Agent Technologies Pty Ltd or Inchain Pty Ltd or the development of this technology, invention or Patent Application comprised Mr Anton Felich.

12. I declare, under penalty of the perjury laws of the United States, that all statements made herein of my own knowledge are true and that all statements made based on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

*[Signature]*

**Nicholas Russell**

8. 11. 96

Date \_\_\_\_\_

## Appendix A

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(19) World Intellectual Property  
Organization  
International Bureau



(43) International Publication Date  
5 February 2004 (05.02.2004)

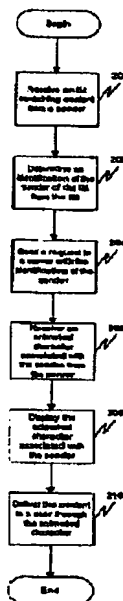
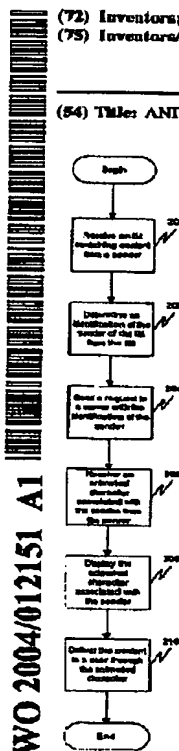
PCT

(10) International Publication Number  
**WO 2004/012151 A1**

- (51) International Patent Classification: G06T 13/00, G06F 13/16, G10L 13/00
- (21) International Application Number: PCT/AU2003/000393
- (22) International Filing Date: 31 March 2003 (31.03.2003)
- (23) Filing Language: English
- (26) Publication Language: English
- (30) Priority Data: 2002950502 31 July 2002 (31.07.2002) AU
- (71) Applicant (for all designated States except US): E-CLIPS INTELLIGENT AGENT TECHNOLOGIES PTY LTD [AU/AU]; 11 Merran Court, Wheelers Hill, VIC 3150 (AU).
- (72) Inventors; and
- (73) Inventors/Applicants (for US only): RUSSELL, Nicholas [AU/AU]; c/- e-Clips Intelligent Agent Technologies Pty Ltd, 11 Merran Court, Wheelers Hill, VIC 3150 (AU). FELICH, Andrew [AU/AU]; c/- e-Clips Intelligent Agent Technologies Pty Ltd, 11 Merran Court, Wheelers Hill, VIC 3150 (AU). JENKINS, James [GB/GB]; 11 Wentworth Way, Saltash, Cornwall PL12 4DG (GB).
- (74) Agents: EARLEY, Martin et al.; Pipers Patent And Trade Mark Attorneys, Level 18, 500 Collins St, Melbourne, VIC 3000 (AU).
- (81) Designated States (national): AE, AG, AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EC, EE, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KR, KG, KP, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NI, NO, NZ, OM, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW.

[Continued on next page]

(54) Title: ANIMATED MESSAGING



(57) Abstract: A method and apparatus that allows an animated interactive talking character to appear on a user's screen when conducting an Instant Messaging (IM) session. The character which is displayed on the user's screen is determined by a profile for the sender of the message. This allows a user to pre-select which character will be displayed on the screen of recipients of the instant messages.